

B5 1/21  
Claim 13 (amended) - The system of claim 12 further including transport means to deliver said award to a player designated locale.

#### REMARKS

The Office Action dated June 24, 2002 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art and certain typographical inexactitudes have been corrected. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

It is believed that the foregoing revisions to the claims are within the metes and bounds of the recently articulated Supreme Court *Festo* case, in that all equivalents susceptible to capture have been retained in that one skilled in the art, at the time of this amendment, could not have reasonably be expected to have drafted a claim that would have literally encompassed any other equivalent.

#### Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1 through 3 and 5 through 15 under 35 U.S.C. § 103(a) as being unpatentable over Eggleston (USP 6,061,660) in view of Walker (USP 6,001,016).

Eggleston et al. discloses a system for providing incentive programs over a computer network, including the Internet. Such incentive programs are linked to specific companies offering promotions and incentives to customers. Hosts may purchase pre-packaged incentive systems or build specific systems (col. 14, lines 26-49).

Customers may participate in incentive program games (e.g., scratch-and-win games, treasure hunts, sweepstakes games) and win awards or accumulate loyalty points.

Walker et al. discloses a system for remote play of a gaming device. Players may, from a remote location, game on particular slot machines in a gaming establishment. The outcome data from the slot machines may be live (col. 10, lines 20-22) or historical (col. 23, lines 1-3). Players may choose to play a particular machine (col. 9, lines 33-36) or may enter a particular game type, bet denomination and bet amount (col. 9, line 65 through col. 10, line 4).

At the outset, undersigned submits that Eggleston is non-analogous art. It is directed to retailers who offer incentive games to customers. Such incentive games are free propositions, designed to encourage a person to purchase products and services from that particular retailer or family of retailers. The present invention is directed to gaming devices, which are intended to accept wagers for games of chance. Offering a free game with the mere possibility of an award does not make such incentive programs comparable to gaming devices in a casino environment.

With respect to claim 1, Eggleston does not concern itself with gaming devices. Information is provided about various incentive programs that reside on the host computer. This is not the same as engaging in a game on an actual gaming device in a casino. Walker provides players with remote access to gaming devices, but says nothing about available awards, promotions or contests. The information provided by the instant invention includes how one may utilize the gaming devices to obtain a particular prize (e.g., which machines to play, how much to bet, odds of winning, etc.). No such teaching is present in Walker. A player may decide how much to bet or what denomination coin to play, but no information about such "special" prizes is

contemplated. Claims 2, 3, 5, and 6 depend from claim 1 and suffer from the same frailty.

The method of claim 7 specifically requires wagering related to potential awards, promotions, and contests, which is not provided in Eggleston. When presented with the present invention, It is not permissible to peruse Eggleston in view of it and boldly assert that one could simply apply Eggleston to wagering devices. Claims 8 and 9 depend from claim 7. The system of claim 10 similarly requires wagering.

These claims have been amended to include the ability to locate information as a function of game type, award kind, or player status. The Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 103.

The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Eggleston in view of Walker, as applied to claims 1 through 3 and 5 through 15, in further view of Leason (USP 6,251,017 B1).

Leason et al. discloses a method of acquiring rewards and reward points, and subsequently redeeming them online.

Claim 4 has been amended to comport with the meaning disclosed in applicant's original disclosure. Leason is no longer applicable to claim 4, and thus, the rejection under 35 U.S.C. § 103 should be withdrawn.

Undersigned is not surprised the Examiner can or has found isolated references that have coincidental similarity with aspects of the present invention. That, however, is not the test for patentability. These references, however, require an enabling teaching apart from applicant's own disclosure.

Undersigned has read these patents carefully and has failed to uncover the basis by which the Examiner has combined these references to support an obviousness type

rejection. Stated alternatively, there is no teaching within these citations that would warrant the combination of elements proposed by the Examiner and it is respectfully stipulated that applicant's structure would still not be obtained thereby. A specific teaching within one of the references suggesting the combination is required:

Undersigned provides the Examiner guidance with respect to rejections under 35 U.S.C. § 103, which is binding, compelling precedent from the Court of Appeals for the Federal Circuit.

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 F.2d at 1143, 227 U.S.P.Q. at 551. Citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 & n. 14, 221 U.S.P.Q. 929, 933 & n. 14 (Fed. Cir. 1984).

"Something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination." *Lindemann Mashcinenfabrick GmbH v. American Hoist and Derrick Co.*, 780 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 437 F.2d 1044 (Fed. Cir. 1988).

These precedents, which are recent decisions from the Court of Appeals for the Federal Circuit, are binding precedents with respect to the manner in which patents showing the prior art can be combined. When relying on these principles, it is apparent that the prior art cannot be combined as the Examiner has proposed because there is no teaching suggesting such a combination.

It is Black Letter Law the Patent and Trademark Office's burden is to establish a prima facie case of obviousness. The Patent and Trademark Office has met its burden only when it fully describes: "1) What the reference discloses, teaches and suggests to one skilled in the art; 2) What the reference lacks in disclosing, teaching or suggesting vis-à-vis the claimed features; 3) What particular teaching or suggestion is being relied upon either via a reference itself or knowledge of person of ordinary skill in the art; 4) A statement explaining the proposed modification in order to establish the prima facie case of obviousness; and finally 5) the motivation behind the statement of obviousness which comes from three sources: a) teachings of the prior art; b) nature of the problem to be solved; or c) knowledge of persons of ordinary skill in the art", see *In re Rouffet* 47 USPQ2d 1453 (Fed. Cir. 1998).

The Examiner has failed to meet these threshold requirements to establish prima facie obviousness:

"Prior art reference, in order to be relied upon as basis for rejecting applicant's invention, must either be in field of applicant's endeavor or, if not, be reasonably pertinent to particular problem with which inventor was concerned; combination of elements from non-analogous sources, in manner that reconstructs applicant's invention only with benefit of hindsight, is insufficient to present prima facie case of obviousness." *In re Oetiker*, 24 U.S.P.Q.2d 1443. [Emphasis added.]

In the absence of such a prima facie showing, the Examiner's rejection cannot stand:

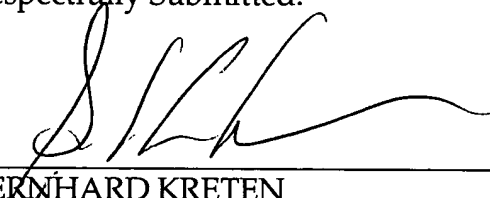
"Decision rejecting claims in utility application as obvious over combination of prior art references must be reversed, since obviousness analysis in decision is limited to discussion of ways that multiple references can be combined to read on claimed invention, but does not particularly identify any suggestion, teaching, or motivation to combine references, and does not include specific or inferential findings concerning identification of relevant art, level of ordinary skill in art, nature of problem to be

solved, or any other factual findings that might support proper obviousness analysis." In re Dembiczak, 50 U.S.P.Q.2d 1614. [Emphasis added.]

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

Dated: December 23, 2002

Respectfully Submitted:



---

BERNHARD KRETEN  
Applicant's Attorney  
Telephone (916) 930-9700  
Registration No.: 27,037